

### **REMARKS/ARGUMENTS**

Responsive to the Official Action mailed July 15 2003, applicant has further amended the claims of his application in an earnest effort to place this case in condition for allowance. Specifically, independent claim 12 has been further amended, and new claims 23-25 added. Reconsideration is respectfully requested.

In the Action, the Examiner has rejected the pending claims under 35 U.S.C. §112, stating that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

For support of his rejection, the Examiner makes reference to the decision of the Patent Office Board of Appeals in *Ex parte Slob*. However, it is respectfully submitted that reliance upon this case is misplaced, and that a careful comparison of the claims at issue in that case, and the presently pending claims, shows that the rejection of the presently pending claims under 35 U.S.C. §112 should be withdrawn. As noted in the Action, the Board objected to broad language in the claims at issue in that case stating that "this language purports to cover everything which will perform the desired functions *regardless of its composition*, and, in effect, recites the compounds by what it is desired that they do *rather than what they are*. (Emphasis supplied). Such conclusions are clearly inconsistent with the presently pending claims. As specifically set forth in the claims, the present durable nonwoven fabric comprises *polyester fibers*. The fabric further comprises a pre-dye finish comprising an *elastomeric polymer emulsion*. Clearly, these claims do not simply recite

desired functions "regardless of its composition", and do not recite the compound by "what it is desired that they do rather than what they are".

Moreover, as will be readily appreciated, the specific physical properties set forth in the presently pending claims are *structural limitations* of the nonwoven fabric construct. It is respectfully submitted that it is inappropriate to simply ignore these structural characteristics when, in fact, those skilled in the art will readily appreciate that such characteristics differentiate the presently disclosed fabric from other nonwoven fabric constructs.

In the Action, the Examiner has stated that the claims are indefinite "for reciting only the desired physical characteristics or properties of the nonwoven fabric, rather than setting forth structural/chemical characteristics of the nonwoven". As noted above, applicant must respectfully disagree, since the stated physical properties set forth in applicant's claims reflect *specific structural features of the nonwoven fabric construct*. These are structural features which are achieved in a construct comprising polyester fibers, and an elastomeric polymer emulsion, as claimed.

Reference is respectfully made to M.P.E.P. Section 2173.01, which specifically provides the manner in which applicants may claim their invention:

They can define in the claims what they regard as their invention *essentially in whatever terms they choose* so long as the terms are not used in ways that are contrary to accepted meanings in the art. *Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought.* (Citation omitted).

As specifically cautioned in M.P.E.P. Section 2173.04, "breadth of a claim is not to be equated with definiteness":

If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, than the claims comply with 35 U.S.C. §112, second paragraph.

Thus, it is respectfully submitted that the rejection of the pending claims under 35 U.S.C. §112 should be withdrawn. It is respectfully maintained that the reliance upon *Ex parte Slob* is inappropriate, given the particular facts of that case. Moreover, as the M.P.E.P. makes clear, so long as claims are definite, and set forth in a manner clear to one skilled in the art, a rejection under 35 U.S.C. §112 is inappropriate. Those skilled in the art will readily appreciate that a nonwoven fabric which does not exhibit the claimed physical properties falls outside the scope of the pending claims. Moreover, there can be no argument but that applicant's specification provides clear and distinct enablement of the present invention, clearly teaching those skilled in the art how to achieve a nonwoven fabric construct exhibiting the recited physical properties.

Consistent with applicant's position, reference is respectfully made to the claims of enclosed U.S. Patent No. 6,534,174, to Ouellette et al., issued earlier this year by the Office.

In the Action, the Examiner continues to reject the claims under 35 U.S.C. §103, now with reliance upon four distinct prior art references. This rejection is respectfully traversed.

It is believed that the requirements for formulating a rejection under 35 U.S.C. §103 are clear. As specifically provided by M.P.E.P. Section 2143.01, the prior must suggest the

desirability of the claimed invention; the level of skill in the art cannot be relied upon to provide the suggestion to combine references. Moreover, the mere fact that the references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In applicant's previous responses, the shortcomings of the references relied upon by the Examiner have been discussed at length. The Examiner's comments in response have been carefully noted. Applicant must respectfully maintain that to choose among the diverse teachings of the references, *which in some instances are in conflict*, is contrary to the required establishments for formulating a rejection under 35 U.S.C. §103.

In connection with U.S. Patent No. 5,874,159, to Cruise et al., the Examiner has stated that the properties of abrasion resistance are noted in this reference. However, as previously noted, this reference clearly *teaches away* from the specifically recited saturation application of a pre-dye finish, in accordance with the present invention.

In the Action, the Examiner states that "Drelich (Patent No. 5,098,764) describes an image transfer device to form an imaged nonwoven fabric with enhanced physical properties and fabric with pleasing appearance. By negative inference, applicant must respectfully understand that this reference fails to teach or suggest applicant's claimed fabric, with the specific structural characteristics recited in applicants' claims. Thus, it is respectfully submitted that this is a tacit admission that Drelich fails to overcome the deficiencies in the teachings of the principal Cruise et al. reference.

While it is acknowledged that Namiki (Patent No. 3,966,406) relates to jet dyeing of fabric, there is little question but that this reference fails to teach or suggest how to achieve a nonwoven fabric which exhibits the structural characteristics in accordance with applicants' invention.

The Examiner has relied upon the Tohyama et al. reference (Patent No. 5,266,354) for its teachings relating to coating a fabric of polyester fiber with a pre-dye finish. However, applicant is unaware of any teaching whatsoever in this reference of employing the techniques disclosed therein for enhancing *abrasion resistance*. As such, applicant must respectfully take exception that this reference can be properly combined with the teachings of Cruise et al., since *the references are addressing completely different problems*. Under such circumstances, applicant can only conclude that his own disclosure is being improperly relied upon to combine the diverse teachings of the preferences.

As set forth in applicant's amended claims, applicant's nonwoven fabric construct is specifically recited as comprising a pre-dye finish comprising an *elastomeric polymer emulsion*. This acts to further clearly distinguish applicant's invention from the cited references. In Cruise et al., there are no teachings or suggestions of employing an elastomeric polymer emulsion for formation of the fabric disclosed therein. The formation of adhesive globules from an *adhesive mesh layer* is specifically disclosed.

Moreover, the Tohyama et al. reference clearly has no teachings or suggestions or employing such an elastomeric polymer emulsion. As previously noted, this reference specifically contemplates the use of porous inorganic particles, whereby a dispersed dye is

caught with the fine pores of the inorganic articles. It is still respectfully maintained that given such express teachings of Tohyama et al., it clearly would not be an obvious expedient to modify the teachings of Cruise et al. for achieving a nonwoven fabric formulated in accordance with the express requirements of the pending claims, and configured to provide the structural characteristics specified in the claims.

Accordingly, reconsideration of the present application is respectfully requested, and allowance of the pending claims respectfully solicited. Should the Examiner wish to speak with applicant's attorneys, they may be reached at the number indicated below.

The Commissioner is hereby authorized to charge any additional fee which may be required in connection with this submission to Deposit Account No. 23-0785.

Respectfully submitted,

By   
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Attachment: U.S. Patent No. 6,534,174